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FROM NAME: Nancy J. Flint
DIRECT DIAL: 305-810-2522

MESSAGE In re Application Of: Rau et. al. Examiner: A.J. Fischer
Application No.: 09/630,595 Art Unit: 3627
Filed: August 1, 2000 Docket No.: 47004.000049
Title: System and Method for Transponder-Enabled Account Transactions

In accordance with 37 CFR 1.8, I hereby certify that the attached correspondence entitled:

1. Notice of Appeal
2. Request for Pre-Appeal Brief Conference

is being facsimile transmitted to the United States Patent and Trademark Office on December 9, 2005,

December 9, 2005
Signature: 
Typed or Printed Name of Person Signing Certificate: Nancy J. Flint
Registration No., if applicable: 46,704

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CLIENT/MATTER NAME/NO.: 47004.000049

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/630,595 Confirmation No.: 5920
Applicant : Scott Rau et. al.
Filed : August 1, 2000
Title : System and Method for Transponder-Enabled Account Transactions
TC/Art Unit : 3627
Examiner: : A. J. Fischer

Docket No. : 47004.000049
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below. Applicants raise herein a rejection that they respectfully submit is clearly not proper and without basis based on a clear legal and factual deficiency and which should be withdrawn, resulting in allowance of all pending claims. Other grounds of appeal also exist, and Applicants do not are hereby waive those grounds by the filing of this Request for Pre-Appeal Brief Conference, and specifically preserve all grounds for appeal.

This application was filed August 1, 2000. An appeal brief was filed previously in this matter on June 17, 2004 which summarized the status of the prosecution to that date. *See* Appeal Brief, June 17, 2004. The Examiner reopened prosecution in response to Applicants' Appeal Brief, and issued a Third Final Rejection in this prosecution. *See* Third Final Rejection, September 13, 2004. In the Third Final Rejection, the Examiner rejected all pending claims as

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allegedly anticipated under 35 U.S.C. § 102(b) by all of U.S. Patent No. 5,276,311 to Hennige *et. al.* ("Hennige"); U.S. Patent No. 5,828,044 to Jun ("Jun"); and U.S. Patent No. 5,859,419 to Wynn ("Wynn"). *See* Third Final Rejection at ¶¶ 7-9. All pending claims were further rejected under 35 U.S.C. § 103 as allegedly unpatentable over Hennige and Jun. *See* Third Final Rejection at ¶¶ 11, 12. In response, Applicants filed an Amendment after Final Rejection and amended claim 26 to include the limitation "wherein the transponder identification information does not comprise financial account information." *See* Amendment after Final Rejection, November 12, 2004, at p. 3. Applicants argued that none of the cited references - Hennige, Jun or Wynn - discloses *inter alia* "receiving by a transponder server of at least one of an issuing bank, a financial institution or a credit network at least some transponder identification information emitted from a transponder substantially upon presentation of both the transponder and a transaction for payment at a point of sale device . . .", where the transponder identification information *does not* comprise financial account information. *See id.* at pp. 8; 9; 10. Rather, in each of Hennige, Jun and Wynn, it is the financial account information itself that is received by the transponder server; there is no disclosure in any of these references of receipt of transponder identification information that *does not comprise* financial account information. *See id.*

An Advisory Action issued stating that the claim amendments in the Amendment after Final Rejection would require further consideration. *See* Advisory Action, November 29, 2004. Applicants filed a Request for Continued Examination and requested entry of the Amendment after Final Rejection of November 12, 2004. A nonfinal Office Action was mailed on April 20, 2005 and all pending claims were rejected under 35 U.S.C. § 102(b) over Hennige, Jun, U.S. Patent No. 6,424,884 to Brook, Jr. *et. al.* ("Brook") and U.S. Patent No. 5,072,380 to Randelman *et. al.* ("Randelman"). The Examiner expressly stated in the rejection under Hennige that the claim limitation "at least some transponder identification information" in claim 26 was met by the disclosure in Hennige of a "credit account number" emitted from the credit card. *See* Office Action, April 20, 2004, at ¶ 14. No explanation of the reasons for the rejections over Jun, Brook and Randelman were given in the Office Action. *See id.* at ¶ 15-17.

Applicants amended claim 26 to *inter alia* limit "account information" to "account number information" and argued in response that the transponder identification information in

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claim 26 expressly, according to the language of the claim, *does not* comprise account number information, and therefore Hennige does not anticipate claim 26. *See* Amendment and Response to Office Action, July 18, 2005, at p. 15. Further, Applicants demonstrated that none of Jun, Brook or Randelman discloses this limitation of claim 26 either. *See id.* at 17-20. Additionally, Applicants argued that claim 26 is not obvious in view of either of Jun or Brook in that each and every limitation of claim 26 is not disclosed by these references and also because these references teach away from the claimed invention of claim 26. *See id.* at pp. 20-25.

In the Fourth Final Rejection, the Examiner rejected claim 26 as allegedly anticipated by two new U.S. patents as references (U.S. Patent No. 5,528,222 to Moskowitz *et. al.* ("Moskowitz") and U.S. Patent No. 5,484,997 to Haynes ("Haynes")). *See* Fourth Final Rejection, October 26, 2005, at ¶¶ 12, 13. Again, the Examiner asserted that "RFID transponder identification information" is interpreted as being the "account number."¹ *See id.* Yet, claim 26 includes the express limitation that the RFID transponder identification information *does not comprise* account number information. *See* claim 26 as amended on July 18, 2005; *see also* 35 U.S.C. § 112, fourth paragraph ("A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.").

Also, the Examiner based this anticipation rejection on the assertion that Moskowitz and Haynes disclose "receiving by a transponder server of an issuing bank the at least some credit card information," where the "at least some credit card information" is the "credit card owner's name or, alternatively, the expiration date of the credit card." *See* Fourth Final Rejection at ¶¶ 12, 13. Claim 26, however, does not include the limitation "at least some credit card information" and so this basis for rejection is improper. Further, the Examiner asserted that the invention of claim 26 is disclosed by Moskowitz and Haynes because these references disclose "an ordinary credit card transaction." *See id.* However, in an ordinary credit card transaction, as described in these references, those of ordinary skill in the art would understand that account

¹ The Examiner makes this assertion only with respect to claim 31. Applicants note that this claim term has proper antecedent basis in claim 26 as well, and are unclear why this interpretation of this claim term is referenced only to claim 31, and not also to claim 26. *See* MPEP § 2173.05(e).

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number information is received by a transponder server of an issuing bank and used to retrieve financial account information. In contrast, in claim 26, the transponder identification information that is received by the transponder server of the issuing bank and used to retrieve financial account information expressly *does not* comprise account number information. The Examiner makes no assertions whatsoever of any references that disclose this second limitation of claim 26. Therefore, a disclosure of "an ordinary credit card transaction" *does not* disclose receiving by a transponder server of an issuing bank "at least some RFID transponder information," which does not comprise account number information, that is used to retrieve financial account information from an account table, and therefore does not disclose each and every limitation of claim 26. Accordingly, the Examiner has not shown that Moskowitz or Haynes anticipates these claims. *See* MPEP § 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Additionally, the rejections under 35 U.S.C. § 103 over Moskowitz and Haynes in view of The Bank Credit Card Business reference by the American Bankers' Association are not sustainable because the ABA reference discloses only a standard credit card transaction, as asserted by the Examiner. *See id.* at ¶¶ 18, 19. No *prima facie* case of obviousness is supported by these references since each and every limitation of claim 26, and specifically the limitation of "receiving by a transponder server of an issuing bank, a financial institution or a credit network at least some RFID transponder identification information emitted from an RFID transponder substantially upon presentation of both the RFID transponder and a transaction for payment at a point of sale device . . .", where the RFID transponder identification information *does not* comprise financial account number information, is not disclosed. No *prima facie* case of obviousness is supported by the combination of these references. *See* MPEP § 2142.

To date, Applicants have maintained that each of the rejections in the Office Actions and Final Rejections fail to properly address each and every claim limitation of the rejected claims. The Examiner has withdrawn all rejections under 35 U.S.C. §§ 101, 102, 103 and 112 first and second paragraphs, except for those stated in the Fourth Final Rejection. *See* Fourth Final

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Rejection at ¶¶ 28-31. Accordingly, rather than proceeding with an expensive and lengthy appeal, Applicants respectfully request that the Office, following consideration of the remarks herein, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection that addresses each and every claim limitation or allow this application to proceed to appeal.

Thus, an appeal on the basis that each and every limitation of independent claim 26 is not disclosed in Moskowitz, Haynes or the ABA reference will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicants when the grounds are so clearly improper. Additionally, where there have already been numerous poorly-constructed and delayed prior art rejections over a period of five (5) years and including the preparation and filing of a previous appeal brief, with only minor claim amendments made since that time, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,

Date: December 9, 2005

By: 

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